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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,682	04/04/2006	Ulrich Bohne	3623	2210

7590
Striker, Striker & Stenby
103 East Neck Road
Huntington, NY 11743

03/16/2010

EXAMINER

MORGAN, EILEEN P

ART UNIT	PAPER NUMBER
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3723

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,682	Applicant(s) BOHNE ET AL.	
	Examiner Eileen P. Morgan	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,9,11-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,9,11-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 23-25 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are drawn to a tool having a gripping surface with housing and wherein the outer surface of conduit forms gripping surface which is drawn to a distinct invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-25 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5,9,11-20,22 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim limitations of the annular gap having a radial extent smaller than diameter of the shaft was not originally disclosed in

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the specification. There is no supporting disclosure that limits the radial extent at all, nor any extent compared to the diameter of shaft.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 11-19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, what is the 'radial extent of annular gap' measured from? It's unclear how the radial extent of the annular gap is smaller than diameter of shaft. The annular gap is around the shaft and therefore cannot be smaller. This is considered new matter not originally disclosed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9,11-20 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Izumisawa-5,919,085.

Izumisawa discloses a hand-held power sander comprising a housing (1,35), motor for driving a shaft (25) extending in longitudinal direction, a first suction conduit

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(42) within housing and having a chamber portion (41) extending longitudinally and surrounding and adjoining spindle (25) and past a bearing flange (the outer surface of spindle 25 that extends down into housing 35, also the disc shaped portion that is not labeled but sits at the base of 25 above pad 28 can be considered a bearing flange) and acting as an intake at a face of the housing that forms an annular gap at the face end of housing between housing and bearing flange and extends perpendicular to longitudinal direction, the suction conduit extending along underside of motor (11,12,13), to an outlet stub (end where 42 joins 43), a tool receptacle (28) having a suction opening (30) (second suction conduit) directly coupled to conduit (42) via a region that is open toward outside of tool (47). The open region is considered the area between the top of 28 and the slanted section of housing 40 (where the line touches on Fig 1). Regarding the radial extent of the annular gap, this is unclear from the claims and as best understood, Izumisawa reads on this. In regard to claim 16, conduit (42) can be sectioned anywhere and one section can have radial extent smaller than another section radial extent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4,5,22 rejected under 35 U.S.C. 103(a) as being unpatentable over Izumisawa, alone.

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Izumisawa discloses a hand-held power sander as detailed above, but does not disclose inner radial region of conduit to be less than 1 cm nor the axial gap size. However, both of these limitations, the inner radial distance and the gap size, would have been obvious design expedients and within the level of one of ordinary skill in the art.

Response to Arguments

Applicant's arguments filed 3-8-10 have been fully considered but they are not persuasive. The restriction of claims 23-25 is upheld. The limitations of the gripping surface and conduit being surrounded by a gripping surface is a distinct invention, and furthermore claim 23 does not include all limitations of claim 1 and does not merely call out a species. Claim 1 regarding the annular gap size is unclear and not understood how the gap, which surrounds the shaft can be smaller than the shaft diameter. This limitation is new matter that was not originally disclosed. Applicant argues that the shaft 16 does not pass through the gap. However, this is confusing since the gap is 'between the bearing flange of shaft and the housing', the shaft extends through the bearing and therefore this does not make sense. The original disclosure does not support this anyway, page 5, lines 6-10 mention nothing of the radial extent or the radial extent compared to shaft diameter. The open region is considered the area between the top of 28 and the slanted section of housing 40 (where the line touches on Fig 1). The region of 47 has a part which is oriented downward but part of 47 is radial and perpendicular to shaft and therefore reads on the claimed limitations and is a proper 102 reference.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen P. Morgan whose telephone number is 571.272.4488. The examiner can normally be reached on Monday-Thursday, 7am-3:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571.272.4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EM

March 11, 2010

/Eileen P Morgan/
Primary Examiner, Art Unit 3723